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File

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July 22, 1977

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New York, New York 10022

Re: H.H. Brown Shoe Co.
Trademark -- "King Kong"

Dear Bill:

I have had several conversations with Mr. Hulbert, attorney for H.H. Brown Shoe Co., and it is readily apparent that his client will not be deterred in its efforts to register "King Kong" as a trademark for work shoes.

The posture of our opposition proceeding is this. Following publication on June 22, 1976 in the Official Gazette we secured extensions of the time within which an opposition was to be filed. The opposition was filed on October 22 and was formalized on November 15. H.H. Brown Shoe answered in January of 1977 and served interrogatories on March 30 of this year. We have secured an extension of time to answer. It now seems, however, that we must fish or cut bait.

Mr. Hulbert is prepared to concede that his client cannot establish a first use of "King Kong" prior to 1935. Indeed, informally at least, he is prepared to concede that his client got the idea for the mark from the motion picture.

Mr. Hulbert also now seems prepared to concede that

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P/C 7/26/77 for Mr. King - another adj. will be held. King will speak to attorney for Brown again re: attempt by plaintiff to establish a first use of "King Kong" prior to 1935. It is anticipated that the possibility of a first use of "King Kong" prior to 1935 will be considered.

William M. Regan, Esq.
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the first motion picture use of "King Kong" created a property right tantamount to a trademark. This is of interest. You will recall our unsuccessful efforts to establish early trademark use through secondary merchandising. I might note that any concession Mr. Hulbert makes in this regard is not binding upon the Patent and Trademark Office. That Office's Trademark Trial and Appeal Board could well insist upon traditional proof of trademark use if prior use is tendered as a basis of an opposition proceeding.

At bottom H.H. Brown Shoe will claim that whatever trademark rights we had have been lost through failure to police those rights and, that in any event there is no likelihood of confusion. In support of the first branch of its argument H.H. Brown Shoe will rely upon (1) its own consistent use of the mark since 1935; (2) the 1950 publication in the Official Gazette of its application to register "King Kong"; and, (3) registrations of "King Kong" by third parties not claiming through us, all of which have been published in the Official Gazette.

We think these arguments, although somewhat convincing, may be overcome if we can establish likelihood of confusion. Confusion involves the public, not merely the parties. If the public be confused they are deceived, and this a court will not lightly countenance.

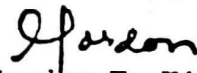
Our difficulty is that in the face of the objective record it will be difficult to prove likelihood of confusion.

The parties have, for example, been coexisting for some forty years without a reported incident of confusion. Indeed, we were not aware of H.H. Brown Shoe's existence until late June of last year.

In summary, Bill, in the light of H.H. Brown Shoe's forty year investment in the mark and, our own apparent lack of diligence in policing it would seem that a showing of likelihood of confusion will be necessary. For reasons alluded to above this may be a difficult task.

Please do let me know what you want done.

Yours sincerely,


Gordon T. King

GTK/jk
cc: John J. Murphy, Esq.
Coudert Brothers

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